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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/715,130

11/18/2003

Matthias Straub

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EXAMINER

HENLEY III, RAYMOND J

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,130

Applicant(s)

STRAUB ET AL.

Examiner

Raymond J. Henley III

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1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-7 and 10-24 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 8 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

CLAIMS 4-24 ARE PRESENTED FOR EXAMINATION

Quayle Action

This action is made under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213. This application is in condition for allowance except for the formal matters noted below under "Claim Objection"

Applicant's Reply filed April 7, 2005 has been received and entered into the application. Accordingly, the specification and claims 4-7 and 11 have been amended and claims 1-3 and 25-38 have been canceled.

In view of these amendments, the specification/claim objection and rejection under 35 U.S.C. § 103(a), as set forth in the previous Office action dated October 8, 2004, are withdrawn.

It is noted that a claim identifier, i.e., (Currently Amended), has been omitted from claim 5 and should be included, if appropriate, in the forthcoming response.

Allowable Subject Matter

Claims 4-7 and 10-24 are in condition for allowance. The prior art fails to indicate that a two-step administration schedule (claim 4) or an administration schedule having two periods of time (claim 11) should or could be used to deliver the active agents. That is, the prior art gives no indication of which of the variety of treatment parameters were critical and no direction as to which of many possible choices should or could be varied. Thus, the Examiner believes that it would have only been "obvious to try" and vary the disclosed administration schedule, which is not a proper basis for concluding obviousness (see MPEP §2145(X)(B)). Even in doing so, the Examiner finds no reasonable basis for concluding that the particular schedule of administration as claimed would have been obvious.

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Claim Objections

Claims 8 and 9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to either cancel the claims or else amend the claims to place them in proper dependent form.

Claim 8 does not further limit the subject matter of claims 4 and 7 because the “stepwise infusion” of claim 8 is already a required condition of the combination of claims 4 and 7. That is, claim 4 requires “two-step administration” and thus provides for a “stepwise” administration. Claim 7, which depends from claim 4, requires that the administration is by “infusion”. Therefore, “by stepwise infusion” of claim 8 is not further limiting.

Claim 9 does not further limit the subject matter of claim 8 because this claim ultimately depends from claim 4 which requires that the administration is “continuous”. The “*partially* continuous” (emphasis added) administration of claim 9 is not further limiting because anything less than “continuous” is not provided for in claim 4.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.


A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Henley III whose telephone number is 571-272-0575. The examiner can normally be reached on M-F, 8:30 am to 4:00 pm Eastern Time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Raymond J Henley III
Primary Examiner
Art Unit 1614

April 20, 2005